

**Petition For Revival Of An Application For Patent Abandoned
Unintentionally Under 37 CFR 1.137(b) (Large Entity)**

Docket No.
T2211-906224

In Re Application Of:

Joseph Giovanni BARRESI et



#20

Application No.
09/355,987

Filing Date
Nov. 18, 1999

Examiner
J. COMBS

Customer No.
181

Group Art Unit
1742

Confirmation No.
7192

Invention:

Improved Foundry Alloy

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JAN 12 2005

OFFICE OF PETITIONS

Attention: Office of Petitions
Mail Stop Petition
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (703) 305-9282.

The above-identified application became abandoned for failure to file a timely and proper response to a notice or action by the Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus any extension of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee--required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

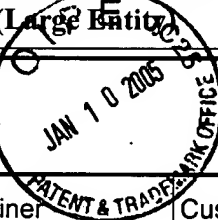
1. ☒ A proposed reply to the above-identified notice or action: 01/11/2005 ZJUHR1 00000054 09355987
01 FC:1453 1500.00 OP
☐ is enclosed. ☒ was filed on March 11, 2002
The proposed reply is in the form of: CPA
2. ☐ The issue fee:
☐ is enclosed. ☐ was paid on _____
3. ☒ The abandoned application was a:
☐ design application. ☒ utility application. ☐ plant application.
4. ☐ A terminal disclaimer (and fee) disclaiming a period equivalent to the period of abandonment is enclosed.
5. ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

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181

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1742

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7192

Invention:

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Calculation and Payment of Fees

Enclosed are the following fees:

6. ☒ Petition fee under 37 CFR 1.17(m) in the amount of: \$1,500.00
7. ☐ Fee for amendment in the amount of: _____
8. ☐ Fee for extension of time to respond to Office Action in the amount of: _____
9. ☐ Issue fee in the amount of: _____
10. ☐ Continuing application filing fee in the amount of: _____
11. ☐ Terminal disclaimer fee in the amount of: _____
12. ☐ _____

Total fees enclosed: \$1,500.00

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The fee of **\$1,500** is to be paid as follows:

- ☒ A check in the amount of the fee is enclosed.
- ☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. **50-1165**
- ☐ Payment by credit card. Form PTO-2038 is attached.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

**Petition For Revival Of An Application For Patent Abandoned
Unintentionally Under 37 CFR 1.137(b) (Large Entity)**

Docket No.
T2211-906224

In Re Application Of:

Joseph Giovanni BARRESI et al

Application No.
09/355,987

Filing Date
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Customer No.
181

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1742

Confirmation No.
7192

Invention:

Improved Foundry Alloy

Statement

The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.


Signature

Edward J. Kondracki
Reg. No. 20,604

Dated: **10 January 2005**

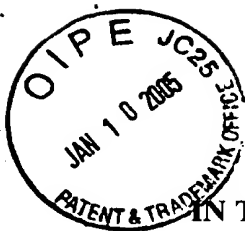
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on

(Date)

Signature of Person Mailing Correspondence

Typed or Printed Name of Person Mailing Correspondence

cc: Customer No. 181



Docket: T2211-906224

IN THE UNITED STATES PATENT AND TRADEMARK O

In re application of : Confirmation No.: 7192
Joseph BARRESI et al. : Group Art Unit: 1742
Serial No.: 09/355,987 : Examiner: Janelle Combs-Morillo
Filed: August 18, 1999 :
For: Improved Foundry Alloy :

McLean, Virginia
January 10, 2005

**STATEMENT IN SUPPORT OF
PETITION TO REVIVE FOR PATENT
ABANDONED UNINTENTIONALLY**

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OFFICE OF PETITIONS

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Sir:

This application was unintentionally abandoned on October 30, 2002, for failure to respond to an Official Action, namely the non-final rejection dated September 11, 2002.

Statement of Relevant Facts

On March 11, 2002, a Continued Prosecution Application Request was filed.

On May 3, 2002, a non-final Office Action was received indicating that the Request filed on March 11, 2002, for continued prosecution application (CPA) was acceptable and that the CPA had been established. A copy of the non-final Office Action is enclosed as Exhibit A. See page 2, numbered paragraph 1, for Examiner's statement of acceptance. The Office Action essentially repeated the objections set forth in the Official Action of September 11, 2001, indicating Claims 16 and 17 to be allowable upon correction of informalities and rejecting Claims 1-3, 5 and 7-20.

On August 16, 2002, the Patent and Trademark Office issued a Notice indicating that the Request for Continued Prosecution Application (CPA) under 37 CFR 1.530(d) was improper, but that the Request for the CPA has been treated as a Request for Continued Examination (RCE) under 37 CFR 1.114.

However, the Notice went on to indicate in a footnote that the "constructive" RCE, was improper because it was not accompanied by a "submission" as required under 37 CFR 1.114. The "submission" referred to is the prior Amendment. A submission is not required in connection with a CPA Request and the "submission" was filed separately.

Apparently, this informality was overlooked inasmuch as an Amendment was filed on September 27, 2002. This Amendment was timely with respect to the Official Action of May 3, 2002, but was not timely with respect to the Official Action Non-Final rejection of September 11, 2001, which the Patent and Trademark Office apparently considered as the operative Official Action when the "constructive" RCE was considered inoperative.

As a result of this oversight, according to PAIR, a Notice of Abandonment was issued on October 31, 2002, under the signature of Roy King, Supervisory Examine because "The CPA (RCE)" filed March 11, 2002, was improper". In a subsequent telephone conversation between Applicant's attorney and the Group Supervisor, Applicant's attorney was advised that the Amendment filed by September 22, 2002, would be accepted as timely.

Based on the telephone conversation with the Group Supervisor, Applicant's attorney was under the impression that the Patent Office Notice of Abandonment would be withdrawn in view of the Examiner's statement that the Request filed on March 11, 2002, was accepted as a CPA, and the Supervisor's acceptance of the follow-up Amendment of September 27, 2002, and as a result did not submit the Notice of Abandonment to docketing..

Subsequently, the Attorney prosecuting this matter has left the Firm without taking further action and these facts came to light only recently when the undersigned reviewed matters being handled by the former attorney and the application file.

Upon review of the application file, the undersigned noted a yellow sticky tab in the file having the notation thereon to a secretary "Vicki please prepare a Petition to Revive based upon unintentional delay. Thanks J".

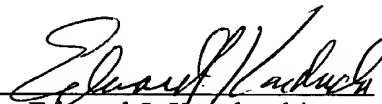
The note never reached the Secretary because the docket entries showed the application to be alive, and there was no reason to pull and examine the file until the responsible attorney left the Firm and his cases were reviewed.

As a result of the foregoing, the application was unintentionally abandoned and revival thereof is earnestly solicited.

I, the undersigned authorized signatory of Applicants, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any resulting patent, declare that I am properly authorized to execute this Statement on behalf of the Applicants.

Respectfully submitted,

MILES & STOCKBRIDGE P.C.

By: 
Edward J. Kondracki
Reg. No. 20,604

1751 Pinnacle Drive, Suite 500
McLean, Virginia 22102-3833
Telephone: (703) 610-8627
#9257024v1



UNITED STATES PATENT AND TRADEMARK OFFICE

JCK
T2211-906224
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/355,987	11/18/1999	JOSEPH GIOVANNI BARRESI	6224/JCK	7192

7590 05/03/2002
MILES & STOCKBRIDGE P.C.
1751 PINNACLE DRIVE, SUITE 500
MCLEAN, VA 22102-3833

EXAMINER

COMBS, JANELL A

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 05/03/2002

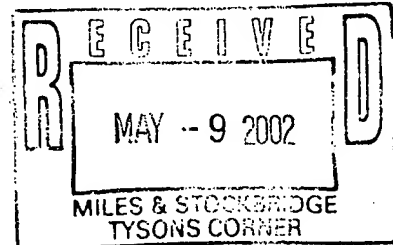
17

Please find below and/or attached an Office communication concerning this application or proceeding.

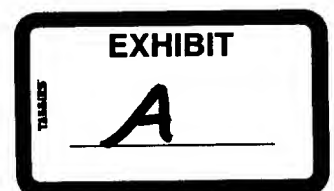
NON-FINAL

DOCKETED
BY [signature] ON 5/10
BY [signature] ON 5/13
DUE DATE 8-3-02
CALL UP _____

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Office Action Summary



Application No.

09/355,987

Applicant(s)

BARRESI ET AL.

Examiner

Janelle Combs-Morillo

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 and 7-20 is/are rejected.
- 7) ☒ Claim(s) 16 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Art Unit: 1742

DETAILED ACTION

Continued Prosecution Application

1. The request filed on March 11, 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/355,987 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Objections

2. Claims 16 and 17 objected to because of the following informalities: claims 16 and 17 are dependent on canceled claim 6. Appropriate correction is required.

Claim Rejections - 35 USC § 103

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 5, 7-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the ASM Handbook: Vol. 2 Properties and Selection: Nonferrous Alloys and Special-Purpose Materials.

The ASM Handbook: Vol. 2 Properties and Selection: Nonferrous Alloys and Special-Purpose Materials teaches that cast aluminum alloy 356.0 has a composition comprising: 0.20-0.45% Mg, 6.5-7.5% Si, and 0.6% max. Fe (page 164), which overlaps the composition as presently claimed in claims 1, 4, 5, and 15. The ASM Handbook: Vol. 2 teaches that "the cells

Art Unit: 1742

contained within the dendrite structure correspond to the dimensions separating the arms of primary dendrites" (page 133, column 2, lines 26-29), and that castings of Al-Si alloy A356 have high strength and high elongation when the dendritic cell size ranges from ~20-40 μm (Fig. 3 page 134). Said Al-Si casting alloy is typically solution heat treated at 535-540°C for 8-12 hours, quenched in hot water (~ 65-100°C), and aged at 150-230°C for 2-9 hours (Table 36, page 168), which are substantially the same process steps as presently claimed in claims 12, 13, 14, 19, 20.

The ASM Handbook: Vol. 2 Properties and Selection: Nonferrous Alloys and Special-Purpose Materials teaches that cast aluminum alloy 357.0 has a composition comprising: 0.45-0.6% Mg, 6.5-7.5% Si, and 0.15% max. Fe (page 166), which overlaps (or touches the boundary) of the composition as presently claimed in claims 1, 4, 5, and 15. Said alloy is typically solution heat treated at 540°C for 8 hours, hot water quenched, followed by aging ~ 170°C for 3-5 hours (page 166), which are substantially the same process steps as presently claimed in claims 12, 13, 14, 19, 20.

The prior art does not teach what phases are present in the final (and intermediate) aluminum alloy processed as stated above. However, the present specification states that "solution treatment at 540°C for 2 or more hours produced desired levels of transformation of π to β phase" (page 8 lines 13-15), which is substantially the same as the solution heat treatment steps of the prior art. The examiner asserts that because the prior art discloses substantially the same aluminum alloy processed in substantially the same steps, substantially the same product would result as presently claimed. It is held the ASM Handbook: Vol. 2 Properties and Selection: Nonferrous Alloys and Special-Purpose Materials has created a prima facie case of obviousness of the presently claimed invention.

Art Unit: 1742

5. Claims 1-3, 5, 7-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over JA 53-16312 in view of the ASM Handbook: Vol. 2 Properties and Selection: Nonferrous Alloys and Special-Purpose Materials.

JA 53-16312 teaches an aluminum alloy comprising 6-8% Si, 0.2-0.4% Mg, and 0.001-0.15% Fe, which overlaps (or touches the boundary) of the composition as presently claimed in claims 1, 4, 5, and 15. Said alloy is processed through the steps comprising: casting, solution heat treating 545-555°C for about 9 hours, quenching in 70°C hot water, and aging at ~130°C for 4 hours (see abstract), which are substantially the same process steps as presently claimed in claims 12, 13, 14, 19, 20.

The prior art of JA 53-16312 does not teach the solidification rate of the casting or what phases are present as the result of the above mentioned process steps. However, the ASM Handbook: Vol. 2 Properties and Selection: Nonferrous Alloys and Special-Purpose Materials, as stated above, teaches the solidification of castings at rapid rates in order to produce high quality castings with small DAS 20-40 μ (p 133-134). The prior art does not teach what phases are present in the final (and intermediate) aluminum alloy processed as stated above. However, the present specification states that "solution treatment at 540°C for 2 or more hours produced desired levels of transformation of π to β phase" (page 8 lines 13-15), which is substantially the same as the solution heat treatment steps of the prior art.

Therefore, it would have been obvious to one of ordinary skill in the art to solidify said aluminum casting (as taught by JA 53-16312) at rapid solidification rates in order to produce a high quality casting as taught by ASM Handbook: Vol. 2, because ASM Handbook: Vol. 2